

REMARKS

Claims 1, 3-10, 14-16, 22-24, 26-29 and 41-45 were pending and examined in the Office Action dated June 1, 2005. Claims 1, 3-10, 14-16, 22-24, 26-29 and 41-45 were rejected in that Office Action. No claims have been added, modified, or deleted by this Response. Applicants respectfully request reconsideration of this application.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 3-10, 14-16, 22-24, 26-29 and 41-45 stand rejected pursuant to 35 U.S.C. § 103(a) as being unpatentable over Alt (5,855,600). The Alt '600 patent discloses a medical device, namely a stent, made from a metal alloy, for example, stainless steel. As the Examiner acknowledges, the Alt '600 patent does not teach that the substrate has an average grain size of one to ten microns, as recited in Applicants' claims. The Examiner has erroneously stated "it would have been obvious matter of design choice to modify the stent of Alt to have such grain size as claimed" by Applicants. Such a "design choice" rejection is tantamount to an "obvious to try" standard, which is not sustainable as a basis for a rejection under § 103(a). Applicants respectfully point out that this is the fourth rejection provided by the USPTO, and the Examiner has yet to show any enabling teaching that a medical device may be formed from a metal alloy having a grain size in the range recited in Applicants' claims. Applicants' claimed invention is not a mere design choice, but a unique and non-obvious structure.

In support of the rejection under §103(a), the Examiner has relied on Ishibashi et al. (6,767,416). As the Examiner must appreciate, the Ishibashi '416 patent, which was filed in the U.S. on February 27, 2002, is not prior art to the present application, which was filed on October 25, 2001. Accordingly, it is improper to rely upon Ishibashi '416 for the proposition that "alloy material with nano grain size" is "well known." It is also noteworthy that the stainless steel disclosed in Ishibashi '416 and the studies cited therein are directed to bulk materials and milled powders having crystal grains in the submicron

size. Thus, there is no teaching or suggestion in any of the references heretofore cited by the Examiner of a medical device having a grain size in the range of one to ten microns.

Applicants are the first to reduce to practice the claimed medical device, and no prior art cited by the Examiner teaches each and every element of Applicants' claims. Furthermore, it is inconsistent for the Examiner to state that it would have been obvious to one of ordinary skill in the art to increase the corrosion resistance and strength of a stent by reducing the grain size as done by Applicants and then imply that such a change in function is not significant or patentable pursuant to Research Corp. v. Nasco Indus. Accordingly, Applicants respectfully submit that the rejection of Applicants' claims under §103(a) is improper and should be withdrawn.

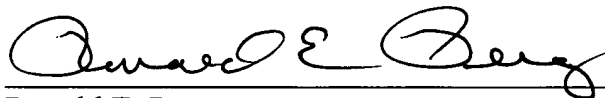
In view of the foregoing, Applicants respectfully submit that all presently pending claims are in condition for allowance, and that the application should be passed to issue. The Examiner is encouraged to contact the undersigned should there be any questions or resolvable matters regarding this application.

Respectfully submitted,

FULWIDER PATTON LEE & UTECHT, LLP

Dated: August 29, 2005

By:



Ronald E. Perez

Registration No. 36,891

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201
99044.1